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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,327	09/26/2003	Christophe Boule	231034US0	5081

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EXAMINER

COTTON, ABIGAIL MANDA

ART UNIT PAPER NUMBER

1617

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/670,327

Applicant(s)

BOULLE ET AL.

Examiner

Abigail M. Cotton

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/26/03, 10/6/03, 1/13/04, 7/5/05 and 9/6/2005
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 16-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/26/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-23 are pending in the application as of the response received on September 6, 2005. Claims 3 and 16-23 are being withdrawn from further consideration as being drawn to a non-elected invention.

### ***Election/Restrictions***

Applicant's election with traverse of the claims of Group I, namely claims 1-15 in the reply received on September 6, 2005, is acknowledged. The traversal is on the ground(s) that a search for both the method of Group I and the composition of Group II would not pose an undue burden on the Office. This is not found persuasive because, while it is noted that the searches of Groups I and II may be overlapping, there is no reason to believe that the searches would be co-extensive. In searching Group II, the Examiner would be focusing on the patentability of the product itself, and not the process of using of Group I. Conversely, in searching Group I, the Examiner has focused on the patentability of the process and not the product itself. Accordingly, a search for both groups would pose an undue burden on the Office.

The requirement is still deemed proper and is therefore made FINAL. Claims 16-23 are being withdrawn from further consideration as being drawn to a non-elected invention.

Applicant's election with traverse of the species of formula Ia in the reply received on September 6, 2005, is acknowledged. The traversal is on the ground(s) that a search for all species of compounds encompassed by the general formula as claimed in claim 1 would not pose an undue burden on the Office. This is not found persuasive because the sheer number of compounds included in this general formula would require significant searching for not only the compounds themselves, but also their uses and effects in various compositions. Accordingly, a search for all species would pose an undue burden on the Office, and the search is restricted for examination purposes to the species elected by Applicants. It is furthermore noted that, upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

The requirement is still deemed proper and is therefore made FINAL. Claim 3 is thus being withdrawn from further consideration as being drawn to a non-elected species of invention.

***Priority***

Applicant's claim of foreign priority to FRANCE 0212261 10/03/2002, is acknowledged.

However, Applicant cannot at present rely upon the foreign priority papers to overcome the following rejections, because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d), a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 4-15 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,641,824 to Duggan et al, issued November 4, 2003, in view of the article entitled "Antifungal Evaluation of Bis Mannich Bases Derived from Acetophenones and Their Corresponding Piperidinols and Stability Studies" by Gul et al, Biol. Pharm. Bull. 25 (10) 1307-1310, October 2002.

Duggan et al. teaches applying a topical application to skin to improve the aesthetic appearance, and particularly to treat and/or reduce fine lines and wrinkles, that comprises a retinoid (see abstract, in particular.) Duggan et al. furthermore teaches that the compositions can comprising additional ingredients including antifungals (see column 4, lines 54-62, in particular.)

Regarding claim 11, Duggan teaches that ingredients provided in the wrinkle treatment composition can comprise antioxidants that scavenge free radicals from the skin (see column 4, lines 33-54, in particular.) Regarding claims 12-15, Duggan et al. teaches the composition can be applied to facial lines and/or wrinkles to improve the appearance thereof, such as on the forehead and/or around the mouth, and diminishes the appearance of the wrinkles, and improves the appearance of suborbital and/or periorbital lines and crow's feet (see column 3, lines 8-30, in particular.)

Duggan et al. does not specifically teach providing the compound corresponding to the elected species of formula (Ia).

Gul et al. teaches that Bis Mannich bases have antifungal activity (see abstract.) Gul et al. teaches that testing of a Bis Mannich base (compound number B1) having the chemical formula that corresponds to Ia shows antifungal activity against dermatophytes (see Table 1 and Conclusions, in particular), which are fungi that are parasitic on skin.

Art Unit: 1617

The Bis Mannich base number B1 as taught by Gul et al. meets the limitations of claims 1-2 and 4-9.

Accordingly, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the Bis Mannich base of Gul et al. in the wrinkle treatment composition of Duggan et al, because Duggan et al. teaches that the wrinkle treatment composition can comprise an antifungal, and Gul et al. teaches that the compound represented by formula (Ia), which corresponds to the elected species, has antifungal activity against fungi that attack the skin. Thus, one of ordinary skill in the art would have been motivated to provide the antifungal of Gul et al. in the topical composition of Duggan et al, with the expectation of providing a wrinkle treatment composition that also has antifungal activity against fungi that attack skin. Thus, claims 1-2 and 4-9 are obvious over the teachings of Duggan et al. and Gul et al.

Regarding claim 10, it is considered that one of ordinary skill in the art would find it obvious to vary and/or optimize the percent weight of the antifungal in the compositions to provide the desired antifungal effects, in accordance with the guidance provided by Duggan et al. and Gul et al. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

**Conclusion**

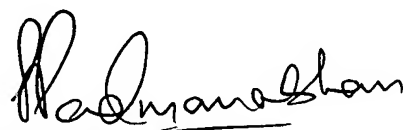
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail M. Cotton whose telephone number is (571) 272-8779. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMC

  
**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**